

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Gross) Art Unit: 3625
Serial No.: 10/770,937)
Filed: 02/2/2004)
For: *Method of providing access to playable media*)

Reply Brief filed under 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Per 37 C.F.R. § 41.41 Appellants submit the present Reply Brief in response to the Examiner's Answer filed on July 8, 2010.

REPLY ARGUMENT

Appellant's Reply Brief is narrowly focussed on a rebuttal of the points raised by the Examiner in his "Response To Argument" discussion beginning on page 22. The other salient points of the rejections in the Answer were already addressed in the main Appeal brief filed by the Appellant.

1. Claim 1

One of the main disputes concerns the following language of the claim, which the Honorable Board has already had one occasion to review – indirectly - during the first appeal of this case:

....wherein steps (c) and (d) are repeated as needed when said automatic queue refill option is enabled so that said subscriber selection queue is maintained automatically for the subscriber so as to include at least one playable media item which is accepted for delivery by such subscriber.

This limitation discusses an automatic queue “refill” option which ensures that the subscriber always has at least one title that can be accepted for delivery. This guarantees that the subscriber will never reach a situation where they do not have a title to enjoy.

The Honorable Board already considered this point indirectly in the first appeal during the request for reconsideration. That is, the main rejection of claim 1 during the first appeal was this point raised by the Board that the Applicant had not *specifically* claimed the automatically maintaining of at least one playable media item behavior at the time. The Board stated (in the rehearing decision dated October 1, 2009) that the claim at that time:

“....does not require that the list *always include at least one playable media*, as asserted by the Appellant because the claim language is conditional upon a confirming response back from the subscriber as to whether to include the media or not.” (emphasis added)

As can be seen above, this point was addressed by the Appellant now modifying the claim to its current incarnation so there would be no further objection to patentability. The Examiner recognizes that the onus is on him to explain this new rejection in light of the Board’s prior decision. Yet he concedes that Hastings does not actually teach this limitation (see e.g., page 23) and now merely states that it is “strongly suggestive.” His argument is stated to be supported by this passage from Hastings that he quotes on page 23 of the Answer:

“In this situation, provider 504 automatically *selects* particular titles that satisfy the movie selection criteria. For example the movie selection criteria may specify a preference for action movies starring a particular actor, or with a preference for ‘new release’ movies.” (emphasis added)

As noted however in the Appeal Brief, all this passage relates is that Hastings has an automated tool for helping users to find and select titles by particular criteria. This is also simply implying that after the movie is selected from inventory and presented to the user, he/she must still manually elect to place the title in his/her queue. If Hastings were also delivering the title to the user or even putting in the subscriber's queue, it would have been a simple matter to state so in the disclosure. But, again, that would be an unreasonable behavior since the mere act of retrieving titles that meet particular selection criteria (for example all Harrison Ford movies) does not mean that the user necessarily wants to receive all of such titles.

Thus the act the Hastings system refers to - "selecting" - merely means it finds titles for the user from a database or inventory of items. This is no different than other conventional e-commerce systems that let customers "select" products to buy, review, etc. The language says nothing whatsoever about actually putting the titles into the user's queue automatically for them, let alone that there is some kind of option that allows the user to ensure that there is always at least one title.

Consequently the Examiner's analysis is fundamentally wrong for a very simple reason. He is confusing statements made in Hastings concerning the system's "selecting" particular titles - that *could* be put in the subscriber's queue - with a separate function, set out in the present claims, of "maintaining" the queue so as to always include at least one playable media item for delivery. The two are separate and distinct functions; the first merely concerns the fact that the system helps the user to "select" titles that could be placed into the queue. Yet Hastings says nothing explicit about automatically maintaining anything, and the Examiner presents no case for inherency.

The Examiner evidences some further confusion about the reference in making this point on page 23 of the Answer:

"...If no modifications of the subscriber selection queue are performed after it is initially set up, then new releases starring the subscriber's favorite actor will not be added if they were not already released at the time that the subscriber queue was created; but if they are not, it would be strange to have the movie selection criteria specify a preference for new releases"

This statement is a non-sequitur and again is simply a disguised inherency argument. Nothing in the Appellant's discussion argues that Hastings' queue cannot be

modified. The question is how it is modified and if it is automatically “maintained.” Again simply because Hastings allows subscribers to find/select new releases does not mean that such titles are automatically placed or maintained in such queue for the subscriber in a manner that ensures that there is always at least one title there.¹

The fact is the passages cited by the Examiner reinforce Appellant’s explanation that the references merely teach that the system can find and select titles based on some criteria; it is up to the subscriber nonetheless to control and ensure that there is always a title available for delivery.

As to the Examiner’s other points on claim 1:

- On page 24 the Examiner takes apparent issue with Applicant’s depiction of Hastings, but notably does not explain how it is inaccurate, wrong, or contradicted by something in Hastings. Indeed the Examiner cites to no actual figure or passage from Hastings to rebut the Appellant’s depiction. The Honorable Board will further note that the commercial implementation of this technology from Hastings at the Netflix.com website confirms Appellant’s description of how this technology is actually implemented. Since the website purports to practice the claims of the reference in question, Appellant submits that it is probative on the issue of which interpretation of the reference is accurate.
- On page 24 the Examiner again acknowledges that nothing in Hastings or Ostrom teaches the claimed limitation. He instead argues that the limitation would have been obvious, but as evidence he provides only a conclusory explanation that it would be “...a plausible way to use the information which Hastings and Ostrom disclose as being obtained.” With all due respect the Examiner here is merely confirming here that he is speculating about how one skilled in the art might have used the reference’s information – there are effectively an infinite number of potential “uses” of such information, a fact that mitigates against a finding of obviousness.

¹ The Examiner’s argument also seems to confuse the difference between a “new” release - which in the industry means a title that is in fact actually released - with the term “future” release, which would refer to a title that is not yet released. Hastings in fact says nothing about selecting, let alone maintaining a queue for future releases.

2. Claim 35

On pages 26 – 27 the Examiner addresses the arguments for claim 35, which includes the additional limitation of the monitoring being done by “....analyzing the content and/or characteristics of other playable media items within said subscriber selection queue...” The Examiner states:

Examiner replies that Hastings discloses that the customer may specify particular titles that the customer desires to rent, or may provide preferences for selecting movies (types of movies, directors, actors, etc.) (column 9, line 63, through column 10, line 14). This is suggestive of analyzing the content and/or characteristics of other playable media items; e.g., if a customer has specified particular titles, and these are tilted to movies of a particular type, or made by particular directors, or starring particular actors, the system could treat these selections as implied preferences, and recommend other movies of the same type, and/or with the same directors or stars. Furthermore, Ostrom

The Examiner’s argument here again fails because it does not address the actual claim language, and/or relies again on inherency arguments that are mere speculations. The issue is not whether Hastings can look at what preference criteria the customer explicitly provides for a title. The issue is whether Hastings ever looks the *content* and/or *characteristics* of items *that are within the subscriber’s selection queue* as part of the monitoring to determine which titles to suggest/add. These items represent titles the customer has already selected for inclusion in their queue; Hastings is completely silent about looking at these items as part of the preference criteria when returning movie selections for its customers.

The remainder of the discussion on pages 26 – 27 is rife with mere speculation about what the system might do; see e.g. page 27: “...the system *could treat* these selections as implied preferences...” This analysis fails because the Examiner is clearly resorting to rank speculation on how he thinks the Hastings system could or should be modified to operate. As this Honorable Board has recognized repeatedly, it is improper to resort to speculation or unfounded assumptions to supply deficiencies in the factual

basis for a rejection. See In re Warner, 379 F.2d 1011, 1017 (CCPA 1967) ("[The Patent Office] may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.").

3. Dependent claims 4, 17, 19

The response to claim 4 again relies on a speculative interpretation of what *might* happen according to Ostrom *if* the customer added a new movie. There is simply nothing in the reference that teaches or suggests what happens to new playable media, let alone that it is "... automatically inserted in a subscriber-defined delivery order position." The reference's lack of disclosure cannot be arbitrarily supplemented with speculative assumptions.

On page 28 for claims 17/19 the Examiner's argument relies on an interpretation for the term "recommendation system" that Appellant has already explained is completely unsupportable in light of the descriptions and definitions provided in the disclosure for such term, which as is well-known, makes *automated* determinations of a user's tastes. The Examiner provides no evidence of any kind that a person skilled in the art would interpret the term in the manner he proposes, i.e. to cover situations where a user specifies Harrison Ford movies, and the system simply returns Harrison Ford movies as selections. A recommender system would be capable of suggesting other actors for example, a fact that is notably absent from Hastings. The other argument by the Examiner concerning "trigger event" again relies on an inherency theory, because the Examiner states he believes the disclosure "implies" the operation set forth in the claim. This, again, is simply an inherency argument without any support.

4. Dependent claim 12

The Examiner now apparently agrees that the motivation he originally proffered for combining Jacobi with Hastings is not entirely accurate, because the two are very different in terms of how they monetize subscribers. All things being equal, more movie

rentals by the subscriber within a subscription period means less profit for the Hastings operator. The Examiner now proposes instead that the motivation instead would be “customer satisfaction,” which he argues would offset this increased customer cost. While this is an admirable goal, the problem is that this “motivation” is taken directly from the Applicant’s disclosure as discussed in several places, including page 18:

In other circumstances, a notice can be sent automatically to those subscribers (i.e., without a setup process by a subscriber) upon determining that their rental selection queue only contains titles that are unavailable (or subject to a long wait). In those instances, again, it is preferable to alert a subscriber to such fact before an undue amount of time passes, and so the subscriber (and/or the system) can take some form of corrective action.

Of course, from a customer satisfaction perspective it makes no sense to send a title that is likely to be undesirable to a subscriber, so it is imperative to select good alternative choices, and this practice must be tempered to some extent.

And on page 35:

In general, from a customer satisfaction perspective, it is desirable to always have at least one title of interest in the possession of the customer, and to reduce stock-out of particular titles for such customer. By identifying potential “weak points” the system can preempt and reduce customer defections by preventing stock-out.

The Examiner’s motivation evidence is simple a paraphrasing of the salient points noted in the disclosure, namely that the main goal is customer satisfaction irrespective of how many titles they may have in their possession, or that they may see in any period. The Examiner simply has provided no evidence to show that, absent the disclosure in Appellant’s specification, a person of ordinary skill in the art would have had a reason to combine Jacobi with Hastings.

5. Dependent claim 13

For this claim the Examiner acknowledges that the motivation is taken directly from Applicant’s own disclosure, and implicitly admits that there is no other evidence of record for the purported evidence of motivation. The Examiner has had several years now to review the claims and identify supporting materials that bear on the issue - the absence of the same at this point belies his argument that such materials could be

found somewhere else. Appellant submits that this clearly illustrates that there is insufficient evidence for the current rejection.

6. Dependent claim 16

Appellant has challenged the applicability of Kamel as an analogous reference, as it has little to do with the present claims. In response the Examiner states that Kamel is analogous because it is “reasonably pertinent to the problem with which the Appellant was concerned, that of replenishing a queue based on its inventory level.” As can be seen from the reference however Kamel is not “replenishing” anything in a queue as the claim calls for. Here the Examiner is confusing the act of replenishing a queue with increasing its size. This is apparent from his rejection where he states that it is well known to add items to a queue which “...has become too small, as taught, for example, by Kamel (paragraphs 161, 162, 167 and 168).” These paragraphs however discuss increasing the size of the queue, not filling it or replenishing it as the claim calls for. There would be no logical reason for Kamel to be replenishing a message queue with additional messages, so it can hardly be the source of inspiration for a skilled artisan considering a problem reasonably pertinent to that which the Appellant is concerned with.

As to the second prong of the Examiner’s argument, that there are a predictable number of solutions to the “problem,” the issue there is that the Examiner fails to identify how the problem was known or recognized in the first place by anyone other than the Appellant. Absent recognition of the problem, there are no predictable solutions.

7. Independent claim 36

The main issue here is the additional language in the claim which states:

- a. repeating step (c) to automatically select and maintain at least one additional media item to be available for immediate delivery to the subscriber at all times;
- b. delivering said at least one additional playable media item when it is accepted by the subscriber;
- c. repeating step (e) when an automatic shipment option is enabled until said subscriber accepts an additional playable media item for delivery.

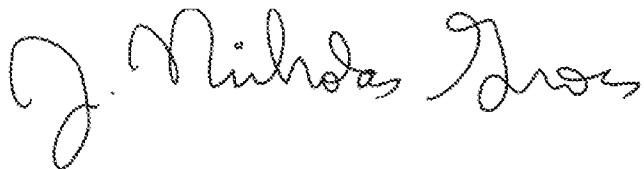
The focus of this claim, again, is to make sure that the customer always has at least one title in their possession to increase their enjoyment of content. Appellant pointed out that the example by the Examiner for “motivation” was inapt because there is a difference in economic incentives between an entity that is selling items, and an entity that is renting the same items under a fixed fee structure. The Examiner now cites as motivation the following argument on page 32:

Examiner has already addressed a very similar point with regard to claim 12: In the short term, Netflix’s revenue from a subscriber does not depend on how many movies the subscriber views, or how much he likes them; but in the long term, the subscriber’s level of satisfaction with the movie delivery service is likely to determine whether the subscriber renews his subscription, and whether he speaks well of Netflix, and induces other people to subscribe. Therefore the motivation set forth is believed to be valid and applicable.

The issue with this argument is that, like claim 12, the purported evidence motivation is taken directly from Appellant’s disclosure as noted in the passages above. The Examiner’s motivation is simple a paraphrasing of the salient points noted in the disclosure, namely that the main goal is customer satisfaction irrespective of how many titles they may have in their possession, or that they may see in any period. There is no other reference or teaching that the Examiner points to for this evidence of motivation and thus the rejection is clearly inadequate.

For the reasons set forth above and in the Appeal Brief Appellant respectfully requests reversal of the rejections.

Respectfully submitted,

A handwritten signature in black ink that reads "J. Nicholas Gross". The signature is fluid and cursive, with "J." and "Nicholas" on the first line and "Gross" on the second line.

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